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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,191	02/18/2000	Paul England	MS1-408US	8393
22801	7590	11/12/2004	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			COLIN, CARL G	
			ART UNIT	PAPER NUMBER
			2136	
DATE MAILED: 11/12/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/507,191	Applicant(s) ENGLAND, PAUL	
	Examiner Carl Colin	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 6/22/2004, the following claims 1-42 are presented for examination.
2. The argument regarding the objection of claim 39 filed on 6/22/2004 has been considered, but Examiner suggests that the term substantially be replaced with another term or omitted.
3. Applicant's arguments, see pages 2-9, filed on 6/22/2004, with respect to the rejection of independent claims 1, 7, 8, 10, 17, 24, 30, and 34, under 35 USC 103 (a) have been fully considered but they are not persuasive. The combination of Ansell and Hertzberg teach the limitations of these independent claims argued by Applicant. Regarding claims 1 and 10, Applicant argues that Ansell does not disclose randomly retrieving data and comparing the retrieved data to a corresponding verification data. Examiner respectfully disagrees. Ansell discloses all the claim limitations of claims 1, 7, 8, and 10 including retrieving data except for specifying randomly retrieving data, which is disclosed in Hertzberg. For instance, in column 8, Ansell discloses "retrieving serial number and keys from storage medium" (*column 8, lines 18-43*) that meets the recitation of retrieving data from a storage medium and further discloses "comparing serial number to media identification data" (*column 8, lines 18-43*) that meets the recitation of comparing the retrieved data to corresponding verification data, and also discloses

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“comparing key with associated digest to determine whether or not to allow execution of the application program (playback)” (*column 8, lines 30-67*). Hertzberg discloses “randomly retrieving data and comparing the retrieved data with corresponding verification data” (*column 2, lines 8-21*). Therefore Examiner maintains rejection. Claims 17, 24, and 30 recite the same inventive concept and remain rejected for the same reason as explained above. Regarding claim 34, Applicant argues that neither Ansell nor Hertzberg discloses issuing a challenge hashing a challenge with data contained in particular data block. Examiner respectfully disagrees. As mentioned above, Ansell discloses key exchange using MAC or message digest to prevent tampering, (see for example column 10 and figure 8 with description). Hertzberg further discloses hashing operation, which is well known in the art, and further discloses randomly selecting data block identifier that identifies a particular data location (see for example column 11, lines 1-10). Examiner maintains rejection. Therefore claims 1-42 are still rejected under 35 USC 103.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1 **Claims 1-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,367,019 to **Ansell et al.** in view of US Patent 5,745,678 to **Herzberg et al.**

4.2 **As per claims 1, 23, 24, 30, and 38, Ansell et al.** substantially discloses a method comprising: retrieving data from a removable data storage medium (see claims 44-48), wherein the removable data storage medium contains an executable application program (see column 2, lines 5-14); comparing the retrieved data to corresponding verification data, wherein the verification data is known to be valid (see claims 44-48); and allowing execution of the executable application program if the retrieved data matches the corresponding verification data (see column 2, lines 28-35). (See also column 8). **Ansell et al.** does not explicitly teach randomly retrieving data. However, **Herzberg et al.** in an analogous art teaches randomly retrieving data to determine if data is valid, for example (see column 2, lines 4-36 and column 5, lines 58 through column 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Ansell et al.** to randomly retrieving data as taught by **Herzberg et al.** in order to more efficiently validate the multimedia program (see column 6, lines 18-34). This modification would have been obvious because one of an ordinary skill in the art would have been motivated by the suggestion provided by **Herzberg et al.** so as to more efficiently validate the multimedia program.

Claim 10 is similar to claim 1. **Ansell et al.** discloses a method comprising: randomly retrieving data from a removable data storage medium (see claims 44-48), wherein the removable data storage medium contains at least one file of audio data (see column 2, lines 5-14); comparing the retrieved data to corresponding verification data, wherein the verification data is known to be valid (see claims 44-48); and allowing execution of the at least one file of audio data if the retrieved data matches the corresponding verification data (see column 2, lines 28-35 and column 5, lines 32-46).

Claim 17 is similar to the rejected claim 1 except for stating data block instead of data. **Herzberg et al.** teaches randomly retrieving at least one data block from the removable data storage medium, wherein the removable data storage medium contains a plurality of data blocks and verifying and validating data block, for example (see column 8, lines 40-67 and column 6, lines 25 et seq. and column 15, lines 14-30). Therefore **claim 17** is rejected on the same rationale as the rejection of **claim 1**.

As per claims 34 and 35, Herzberg et al. substantially discloses a method comprising: randomly selecting a data block identifier, wherein the data block identifier identifies a particular data block on a removable data storage medium in different embodiments, for example (see column 11, lines 9-12 and column 8, lines 40-50 and lines 10-24); issuing a challenge and the data block identifier to a data reading device, wherein the removable data storage medium is readable by the data reading device, for example (see column 8, lines 45-67 and column 10, lines 24-67); hashing the challenge with the data contained in the particular data block on the

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removable data storage medium (see columns 8-9 and column 10; column 12); receiving the result of the hashing operation medium, for example (see column 8, lines 45-67 and column 10, lines 37-67); comparing the result of the hashing operation to corresponding verification data, wherein the verification data is known to be valid, for example (see column 8, lines 45-67 and column 10, lines 37-67); and determining that the removable data storage medium is legitimate if the result of the hashing operation matches the corresponding verification data, for example (see column 8, lines 45-67 and column 10, lines 37-67). To one skilled in the art it is apparent that the limitations of claim 34 are disclosed by **Herzberg et al.**

Claims 39 and 40 are similar to the rejected claim 17 except for performing a cryptographic operation and obtain a digest. **Herzberg et al.** teaches randomly retrieving at least one data block from the removable data storage medium, and performing cryptographic operation to obtain a first and second digest to match, for example (see column 8, lines 40-67 and column 12, lines 20-67, and column 15, lines 14-30). Therefore **claims 39 and 40** are rejected on the same rationale as the rejection of **claim 17**.

As per claim 41, Herzberg et al. discloses performing secure hash algorithm, for example (see column 10, lines 21-26).

As per claim 42, Herzberg et al. discloses second digest is stored in a different medium than the one the data blocks are stored, for example (see column 8, lines 40-67 and column 12, lines 20-67, and column 15, lines 14-30).

As per claims 2, 11, and 31, Ansell et al. discloses the limitation of further including preventing execution of the executable application program and at least one file of audio data if the retrieved data does not match the corresponding verification data (see column 2, lines 5-14).

As per claim 3, Ansell et al. discloses the limitation of wherein the executable application program is executed from the removable data storage medium (see column 2, lines 5-14).

As per claim 4, Ansell et al. discloses the limitation of wherein the executable application program is executed from the removable data storage medium (column 2, lines 28-51).

As per claims 5, 12, 19, 26, 32, and 36, Ansell et al. discloses the limitation of wherein the removable data storage medium is a compact disc (CD) (see column 5, lines 20-25).

As per claims 6, 13, 20, 27, 33, and 37, Ansell et al. discloses the limitation of wherein the removable data storage medium is a digital versatile disc (DVD) (see column 5, lines 20-25).

As per claim 7, Ansell et al. discloses the limitation of further including partitioning the removable data storage medium into a plurality of data blocks (column 5, line 47 through column 6).

As per claim 8, Ansell et al. discloses the limitation of further including: partitioning the removable data storage medium into a plurality of data blocks; and calculating a cryptographic digest for each of the plurality of data blocks (column 5, line 47 through column 7).

Claims 9 and 16 have the same limitation as **claim 1** except for incorporating the claimed method into a computer-readable medium containing a program to perform the steps of claim 1. Therefore, **claims 9 and 16** are rejected on the same rationale as the rejection of **claim 1**.

As per claim 14, Ansell et al. discloses the limitation of wherein allowing access to the at least one file of audio data includes installing the at least one file of audio data to a handheld audio player (column 5, lines 19-46).

As per claim 15, Ansell et al. discloses the limitation of wherein allowing access to the at least one file of audio data includes playing the at least one file of audio data to a handheld audio player (column 5, lines 19-46).

As per claims 18 and 25, Herzberg et al. discloses the limitation of further including determining that a legitimate removable data storage medium is not present if the retrieved data block does not match the corresponding verification data block (see column 8, lines 40-67).

As per claim 21, Herzberg et al. discloses the limitation of calculating a cryptographic digest for each retrieved data block, wherein the verification data block has an associated cryptographic digest, for example (see column 8, lines 40-67 and column 6, lines 25 et seq. and column 15, lines 14-30).

As per claim 22, Herzberg et al. discloses the limitation of wherein comparing the retrieved data block to a corresponding verification data block comprises comparing the cryptographic digest of the retrieved data block with the cryptographic digest associated with the verification data block, for example (see column 8, lines 40-67 and column 6, lines 25 et seq. and column 15, lines 14-30).

As per claim 28, Ansell et al. discloses the limitation of wherein the verification module and the data reading device are coupled to one another across the Internet (column 4, lines 55-67).

As per claim 29, Ansell et al. discloses the limitation of wherein the verification module is located in a handheld audio player and the data reading device is located in a computer system coupled to the handheld audio player (see column 4 and figure 1).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Carl Colin

Patent Examiner

November 2, 2004


AYAZ SHEIKH
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